

REMARKS

This paper is filed in response to the non-final Office action mailed on June 19, 2009. In that Office action, claims 1-50 were rejected as directed to non-statutory subject matter, claims 1-11, 14-17, 24, 27, 39-43, and 51 were rejected as being anticipated by the prior art, and claims 12-13, 30-38, 44-45, and 50 were rejected as being obvious over combinations of the prior art. Additionally, the Examiner indicated that claims 18-23, 35-26, 28-29, and 46-49 recited allowable subject matter. Each of the claims has been amended to address antecedent basis and other informal issues. Additional amendments are presented in independent claims 1, 24, 27, 30, 39, 43, 44, 50, and 51. No new matter has been added. Claims 1-51 remain pending in the application. In view of the foregoing amendments and following remarks, Applicant respectfully requests reconsideration and allowance of all pending claims.

Claim Rejections – 35 U.S.C. §101

At the outset, claims 1-50 were rejected under 35 U.S.C. § 101 as reciting non-statutory subject matter. More specifically, the Examiner asserts that the claims recite a “process,” which must either: “(1) be tied to a particular machine, or (2) transform underlying subject matter (such as an article or material) to a different state or thing.” To support the conclusion that the claims do not recite non-statutory subject matter, the Examiner offers repetitive conclusory statements that fail to address or analyze the actual language of the claims. More specifically, the Examiner generally alleges that claims 1-50:

...are neither positively tied to a particular machine that accomplishes the claimed method steps nor transform underlying subject matter, and therefore do not qualify as a statutory process. [The claims] could be completely performed mentally, verbally or without a machine nor is any transformation apparent. The method claims are not tied to a particular machine nor do they transform underlying subject matter.

Each of the claims rejected on this ground, in either the original form or as amended herein, specifies a process that is tied to a particular machine, thereby satisfying at least the first prong of the Bilski analysis. Accordingly, the rejection under 35 U.S.C. § 101 must be withdrawn.

More specifically, independent claim 1 positively recites a remote facility and a remote machine. A software option is associated with a machine function of the remote machine. A second enabling signal is delivered to the remote machine and is configured to enable the

software option. Accordingly, the process specified in claim 1 is tied to a particular machine, namely the remote machine, and is not capable of being completely performed mentally, verbally, or without a machine. Independent claims 30 and 39 recite similar elements, and therefore also recite statutory subject matter.

Independent claim 24 positively recites a remote machine having a plurality of controllers. The method includes distributing at least a portion of an enabling signal to the plurality of controllers, and therefore meets the requirement of being tied to a particular machine.

Independent claim 27 positively recites a replacement processor and a failed processor. A software option is associated with a machine function of a remote machine. An enabling signal is delivered to the replacement processor that enables the software option. Accordingly, the process specified in claim 27 is tied to a particular machine, namely the replacement and failed processors.

Independent claim 43 positively recites a remote machine having a machine function associated with a software option. The method specifies disabling the software option on the remote machine, and therefore meets the requirement of being tied to a particular machine.

Independent claim 44 positively recites a remote customer machine having a machine function associated with a software option. The method includes delivering an enabling signal to the remote customer machine that is configured to enable the software option, and therefore meets the requirement of being tied to a particular machine.

Independent claim 49 positively recites a remote location, an intermediary, and a remote machine. The method includes delivering an enabling signal from the remote location, to the intermediary, and further to the remote machine, and therefore meets the requirement of being tied to a particular machine.

Independent claim 50 positively recites a first machine having a machine function associated with a software option, and a second machine. The method includes delivering a request to enable the software option on the first machine to the second machine, disabling the software option on the second machine, and enabling the software option on the first machine, and therefore meets the requirement of being tied to a particular machine.

In view of the foregoing, Applicant respectfully submits that the non-statutory subject matter rejection of claims 1-50 must fail and should be withdrawn.

Claim Rejections – 35 U.S.C. §102

Turning to the prior art rejections, claims 1-11, 14-17, 24, 39-42, and 51 were rejected under 35 U.S.C. § 102(e) as anticipated by U.S. Patent Application Publication No. 2007/0050301 (“Johnson”). To anticipate a claim, however, MPEP § 2131 requires a single prior art reference to disclose each and every limitation of the claim. Applicant submits that each of the pending claims includes one or more elements that are not disclosed by Johnson, thereby overcoming the aforementioned rejection, as discussed more specifically below.

Johnson fails to disclose each element of independent claim 1, and therefore the anticipation rejection asserted against claims 1-11 and 14-17 must be withdrawn. More specifically, independent claim 1, as well as claims 2-23 depending directly or indirectly thereon, specifies a method of enabling a software option located on a remote machine having a machine function associated with the software option. The method includes receiving a request, at a remote facility configured to authorize the request, to enable the software option associated with the machine function, authorizing the request, delivering a first enabling signal, from the remote facility, to an intermediary in response to the authorization, and delivering a second enabling signal, from the intermediary, to the remote machine in response to the first enabling signal, the second enabling signal configured to enable the software option. Johnson fails to disclose a method having a software option located on a remote machine and associated with a machine function, in which an enabling signal is delivered to the remote machine that is configured to enable the software option.

Instead, Johnson discloses a system for monitoring the number and usage of licenses of an application over a network in which a customer is allotted a number of excess licenses. If an excess license is used, a notification is sent to the customer and the customer is billed. If the customer timely pays, an updated license file is transmitted to the customer. (See Johnson, paragraph [0006]). The updated license file may be sent when the customer purchases a new product or when the customer purchases additional licenses. (Johnson, paragraph [0033]). To obtain a new license, the customer must contact a representative and download the new license file to their server. (Johnson, paragraph [0034]). To obtain an updated license, the customer

receives an email with instructions to log onto a URL to validate and receive the updated license file. (Johnson, paragraph [0035]). The Examiner argues that the “license” of Johnson is responsive to the software option specified in the claims. While the Examiner does not specify whether he is referring to a “new license” or an “updated license,” in both instances the license disclosed in Johnson must be downloaded from a web site. Significantly, therefore, the system of Johnson merely monitors the number and usage of licenses of an application. The transmission of the license does not enable the application, as it is already enabled and in use by the customer. Consequently, the licensing management method of Johnson does not include delivering a second enabling signal to the remote machine that is configured to enable the software option, as specified in claim 1. Accordingly, Johnson fails to disclose each element of independent claim 1, and therefore the anticipation rejection of claims 1-11 and 14-17 based upon Johnson must be withdrawn.

Johnson also fails to disclose or suggest each element of independent claim 24, and therefore the rejection of this claim must be withdrawn. Similar to claim 1 noted above, independent claim 24 specifies a method having a software option located on a remote machine and associated with a machine function, in which an enabling signal is delivered to the remote machine that is configured to enable the software option. As noted above, Johnson fails to disclose these elements. Additionally, claim 24 specifies distributing at least a portion of an enabling signal to a plurality of controllers located on the remote machine. Johnson fails to disclose or suggest the use of a plurality of controllers, let alone distributing a portion of an enabling signal to the plurality of controllers. Accordingly, Johnson fails to disclose each element of independent claim 24, and therefore the anticipation rejection thereof must be withdrawn.

Still further, Johnson fails to disclose or suggest each element of independent claim 39, and therefore the anticipation rejection of claims 39-42 must be withdrawn. Similar to claim 1 noted above, independent claim 39 specifies a method having a software option located on a remote machine and associated with a machine function, in which an enabling signal is delivered to the remote machine that is configured to enable the software option. As noted above, Johnson fails to disclose these elements, and therefore the anticipation rejection of claims 39-42 based on Johnson must be withdrawn.

Finally, Johnson fails to disclose or suggest each element of independent claim 51, and therefore the anticipation rejection of this claim must be withdrawn. Claim 51 specifies a system configured to enable a software option located on a remote machine having a machine function associated with the software option. The system includes a controller located on the remote machine, the controller being configured to generate a request to enable the software option associated with the machine function of the remote machine. A remote facility is configured to receive the request, authorize the request and generate a first enabling signal. An intermediary is configured to receive the first enabling signal from the remote facility, authenticate the first enabling signal, and responsively deliver a second enabling signal to the remote machine in response to the first enabling signal, the second enabling signal configured to enable the software option. Johnson fails to disclose a system having an intermediary configured to deliver a second enabling signal to the remote machine that is configured to enable the software option.

Instead, as noted above with respect to the rejection of claim 1, Johnson discloses a system for monitoring the number and usage of licenses of an application over a network in which a customer is allotted a number of excess licenses. The system of Johnson merely monitors the number and usage of licenses of an application. The transmission of the license does not enable the application, as it is already in use by the customer. Consequently, the licensing management method of Johnson does not include an intermediary configured to deliver a second enabling signal to the remote machine that is configured to enable the software option, as specified in claim 51. Accordingly, Johnson fails to disclose each element of independent claim 51, and therefore the anticipation rejection of that claim based upon Johnson must be withdrawn.

Claim 27 was rejected under 35 U.S.C. § 102(c) as anticipated by U.S. Patent Application Publication No. 2005/0038751 ("Gaetano"). To anticipate a claim, however, MPEP § 2131 requires a single prior art reference to disclose each and every limitation of the claim. Applicant submits that claim 27 includes one or more elements that are not disclosed by Gaetano, thereby overcoming the aforementioned rejection, as discussed more specifically below.

As an initial matter, the rejection based on Gaetano is unduly vague. As stated in the current office action, the rejection merely reproduces the language of claim 27 and adds a parenthetical statement generally referring to paragraphs [0063] to [0067] of Gaetano and listing

elements disclosed in Gaetano, without identifying which components of Gaetano correspond to which elements of the claim. It is difficult, therefore, for Applicants to fully respond to the Office action as it is unclear what the Examiner finds responsive to certain of the elements specified in claim 27. For example, it is unclear from the Office action what in Gaetano is considered responsive to the “software option” and “delivering an enabling signal” as specified in claim 27. Clarification of the basis for rejecting the claims is respectfully requested. Notwithstanding the foregoing, Applicants attempt to substantively address this ground of rejection below.

Gaetano fails to disclose each element of independent claim 27, and therefore the anticipation rejection asserted against that claim must be withdrawn. More specifically, independent claim 27 specifies a method of enabling a software option located on a replacement processor of a remote machine having a machine function associated with the software option. The method includes identifying a failed processor associated with the replacement processor, receiving a request to enable the software option associated with the machine function, authorizing the request in response to said identifying of the failed processor, and delivering an enabling signal to the replacement processor in response to the authorization, the enabling signal configured to enable the software option. Gaetano fails to disclose a method having a software option located on a remote machine and associated with a machine function, in which an enabling signal is delivered to the replacement processor that is configured to enable the software option.

Instead, Gaetano discloses a software site licensing system for telecommunication software applications. (Gaetano, paragraph [0032]). The system includes a license sales site that delivers a license file to a programming workstation. The programming workstation includes storage for the license file and a management application, which manages the received license as well as any previously sent licenses. The programming workstation is connected to a target computer, which can upload and install the license. The target computer controls a site application and the license provides clearance for the site application to run. (Gaetano, paragraph [0033]). The system may include the use of a special license for failover situations, to permit a switchover from a master CPU to a backup CPU. The master and backup CPUs share a license, in which the system tags the backup CPU with a backup key that identifies it for backup

use. When both systems are operable, the backup CPU copies the license data from the master CPU. (Gaetano, paragraph [0064]). Significantly, if the license file is considered to be the claimed software option, then it is evident that a copy of the license file must be copied from the master CPU to the backup CPU, and therefore the license file is delivered to the backup CPU rather than enabled. Furthermore, the license file is not associated with a machine function of a remote machine, but merely “provides clearance” for a site application to run. Accordingly, Gaetano fails to disclose or suggest a software option as specified in claim 27, and therefore the anticipation rejection based thereon must be withdrawn.

Claim 43 was rejected under 35 U.S.C. § 102(e) as anticipated by U.S. Patent Application Publication No. 2003/0046189 (“Asayama”). To anticipate a claim, however, MPEP § 2131 requires a single prior art reference to disclose each and every limitation of the claim. Applicant submits that claim 43 includes one or more elements that are not disclosed by Asayama, thereby overcoming the aforementioned rejection, as discussed more specifically below.

Asayama fails to disclose each element of independent claim 43, and therefore the anticipation rejection asserted against this claim must be withdrawn. More specifically, independent claim 43 specifies a method of disabling a software option located on a remote machine having a machine function associated with the software option. The method includes receiving a request, at a remote facility, to disable the software option associated with the machine function of the remote machine, disabling the software option on the remote machine, and receiving a disabled characteristic associated with the software option. Asayama fails to disclose or suggest receiving a request to disable at a remote facility as specified in claim 43.

Instead, Asayama discloses a system for a server to enable and disable client computer software features for use with a web-based communications platform for managing marketing campaigns. (Asayama, paragraph [0007]). The software features are multimedia messages. The server 100 includes an authorization system 110 having an authorization engine 300, a user activity monitoring engine 310, and a user database 320. The authorization engine 300 sends commands to user platform 130 to enable or disable software features 420 stored in the user platform 130. The authorization engine 300 determines when to send new features and/or commands to enable or disable features based on data stored in the user database 320. (Asayama, paragraph [0025]). The user activating-monitoring engine 310 monitors activity on user

platform 130 during marketing campaigns and updates user database 330. Based on user activity, the authorization engine 300 then sends a command to the user platform 130 to enable the software feature. (Asayama, paragraph [0026]). Significantly, therefore, if one considers the user platform 130 to be the remote machine and the authorization engine 300 to be the remote facility, then it is evident that a request to disable a software feature is generated by the authorization engine based on observed activity, and therefore is not “received” by the authorization engine, as required by claim 43. Consequently, Asayama fails to disclose or suggest each element of claim 43, and the anticipation rejection based thereon must be withdrawn.

Claim Rejections – 35 U.S.C. §103

In the outstanding Office action, claims 12-13, 30-38, 44-45, and 50 were rejected under 35 U.S.C. § 103(a) as being unpatentable over combinations of the prior art. To support an obviousness rejection, however, MPEP §2143.03 requires “all words of a claim to be considered” and MPEP §2141.02 requires consideration of the “[claimed] invention and prior art as a whole.” Further, the Board of Patent Appeals and Interferences recently confirmed that a proper, post-*KSR* obviousness determination still requires the Office to make “a searching comparison of the claimed invention – including all its limitations – with the teaching of the prior art.” See, *In re Wada and Murphy*, Appeal 2007-3733, citing *In re Ochiai*, 71 F.3d 1565, 1572 (Fed. Cir. 1995). Applicant submits that none of the proposed combinations of the prior art discloses or suggests every limitation of the pending claims, thereby overcoming the aforementioned rejections, as discussed more specifically below.

Claims 12-13 stand rejected as being obvious over the combination of Johnson and Gaetano. Specifically, the Examiner asserts that Johnson teaches all of the limitations of the claims except for generating the request “in response to a controller failing/wherein said request includes a failed controller characteristic and a replacement controller characteristic.” The Examiner thus relies upon Gaetano to supply Johnson with the elements noted above. Johnson has been previously discussed as failing to teach all of the limitations of claim 1, from which claims 12-13 depend. Specifically, Johnson fails to disclose or suggest a method having a software option located on a remote machine and associated with a machine function, in which an enabling signal is delivered to the remote machine that is configured to enable the software

option. In addressing the anticipation rejection of claim 27, Gaetano was discussed above as also failing to disclose or suggest these elements. Accordingly, as the combination of Johnson and Gaetano fails to teach or suggest all of the limitations of independent claim 1, the obviousness rejection of claims 12-13 based upon that combination must also fail and should be withdrawn.

Claims 30-38 and 50 were rejected as being obvious over Asayama in view of U.S. Patent No. 5,933,497 ("Beetcher"). More specifically, the Examiner asserts that Asayama teaches all of the limitations of independent claims 30 and 50 except for an entitlement. The Examiner thus relies upon Beetcher, as well as Official Notice, to supply Asayama with an entitlement. In addressing the anticipation rejection of claim 43, Asayama is discussed above as failing to teach or suggest receiving, at a remote facility, a request to disable the enabled software option on the remote machine, as specified in claim 30. Beetcher fails to disclose or suggest this element, and therefore the obviousness rejection of claim 30 based upon the combination of Asayama and Beetcher must also fail and should be withdrawn.

Regarding claim 50, the rejection as stated fails to address the specific language of the rejected claim. Instead, the rejection as stated only addresses the elements recited in claim 30, and fails to identify what features of claim 50 are disclosed or suggested by the cited prior art. Accordingly, this ground of rejection must be withdrawn.

Additionally, the combination of Asayama and Beetcher fails to disclose or suggest each element of claim 50. Claim 50 recites a method of enabling a software option located on a first machine having a machine function associated with the software option. The method includes establishing a need for a software option on a first machine, delivering a request to enable the software option on the first machine to a second machine, disabling the software option on the second machine in response to the request, generating an enabling signal in response to the disablement, and enabling the software option on the first machine in response to the enabling signal. The combination of Asayama and Beetcher fails to disclose or suggest disabling the software option on the second machine in response to the request, generating an enabling signal in response to the disablement, and enabling the software option on the first machine in response to the enabling signal.

Instead, Asayama teaches a system for a server to enable and disable client computer software features for use with a web-based communications platform for managing marketing

campaigns. (Asayama, paragraph [0007]). The software features are multimedia messages. The server 100 includes an authorization system 110 having an authorization engine 300, a user activity monitoring engine 310, and a user database 320. The authorization engine 300 sends commands to user platform 130 to enable or disable software features 420 stored in the user platform 130. The authorization engine 300 determines when to send new features and/or commands to enable or disable features based on data stored in the user database 320. (Asayama, paragraph [0025]). The user activating-monitoring engine 310 monitors activity on user platform 130 during marketing campaigns and updates user database 330. Based on user activity, the authorization engine 300 then sends a command to the user platform 130 to enable the software feature. (Asayama, paragraph [0026]). At any time, the system of Asayama may disable a feature on one user platform while enabling a feature on another user platform. The determination whether to send a disabling/enabling command is made solely by the user activating-monitoring engine 310, and is based on observed activity by a user. Accordingly, Asayama fails to disclose or suggest that the enabling/disabling command to one platform is predicated on a disabling/enabling command to another platform as specified in claim 50. Specifically, claim 50 requires disabling the software option on the second machine in response to the request, generating an enabling signal in response to the disablement, and enabling the software option on the first machine in response to the enabling signal. Asayama treats each user platform individually, and therefore fails to disclose or suggest each of these elements. Beetcher also fails to disclose or suggest these elements, and therefore the rejection of claim 50 based on the combination of Asayama and Beetcher must fail and should be withdrawn.

Claims 44-45 were rejected as being obvious over Johnson. Johnson, however, fails to teach or suggest each element of independent claim 44, and therefore Applicants traverse this ground of rejection.

Independent claim 44, as well as claims 45-48 depending directly or indirectly thereon, specifies a method of enabling a software option located on a remote customer machine having a machine function associated with the software option. The method includes receiving a request by a manufacturer from a dealer to enable the software option associated with the machine function of the remote customer machine, authorizing the request in response to a dealer characteristic and a machine characteristic, and delivering an enabling signal to the remote

customer machine, the enabling signal configured to enable the software option. Johnson fails to disclose or suggest such a method.

Instead, as noted above, Johnson discloses a system for monitoring the number and usage of licenses of an application over a network in which a customer is allotted a number of excess licenses. The system of Johnson merely monitors the number and usage of licenses of an application. The transmission of the license does not enable the application, as it is already in use by the customer. Consequently, the licensing management method of Johnson does not include delivering an enabling signal to the remote customer machine that is configured to enable the software option, as specified in claim 44. Accordingly, Johnson fails to disclose each element of independent claim 44, and therefore the obviousness rejection of claims 44-45 based upon Johnson must fail and should be withdrawn.

CONCLUSION

It is submitted that the present application is in good and proper form for allowance. A favorable action on the part of the Examiner is respectfully solicited. If, in the opinion of the Examiner, a telephone conference would expedite prosecution of the subject application, the Examiner is invited to call the undersigned agent.

The Patent Office is hereby authorized to credit any overpayment or charge any deficiency in the fees filed, asserted to be filed, or which should have been filed herewith to our Deposit Account No. 50-3629.

Dated: October 15, 2009

Respectfully submitted,

By /brent e matthias/
Brent E. Matthias
Registration No.: 41,974
MILLER, MATTHIAS & HULL
One North Franklin Street
Suite 2350
Chicago, Illinois 60606
(312) 977-9902
Agent for Applicant